

REMARKS

Applicants respectfully request reconsideration of the present Application in view of the foregoing amendments and in view of the reasons that follow.

With this Amendment, Claims 31, 42, 49, and 52 have been amended; No Claims have been canceled; and, no Claims are new. A detailed listing of all claims that are, or were, in the Application, irrespective of whether the claims remain under examination in the Application, is presented, with appropriately defined status identifiers. Thus, Claims 28-54 remain pending in the Application.

Support for the amendments to Claims 31, 42, and 52 can be found in the disclosure in at least Fig. 7 and paragraphs [0037]-[0048]. Support for the amendment to claim 49 can be found in at least Fig. 11 and paragraph [0067]. No new matter has been added.

Double-patenting rejection

The outstanding Official Action has rejected claims 28-54 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-27 of U.S. Patent No. 6,974,926.

Attached herewith is a terminal disclaimer under 37 CFR 1.321(c). Thus, this rejection is moot.

Claims rejections under 35 U.S.C. § 112

The outstanding Official Action has rejected claims 49 and 50 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement, specifically, that the specification does not mention the components coupled as claimed or provide why or how such coupling would occur.

Claim 49 has been amended to recite, inter alia, “[a] system, comprising: a piezoelectric tube coupled to a collected target nanotube, wherein the collected target nanotube was collected by an apparatus...” That is, claim 49 has been amended to conform with the device illustrated in Fig. 11 and described in paragraph [0067] of the specification. Applicants respectfully request withdrawal of the rejection.

The outstanding Official Action has rejected claims 42-51 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically, claim 42 was rejected because “it is not clear if the fluid layers are actually required by the apparatus.” Claim 49 was rejected because “it is not clear what if any structure is actually required of the apparatus.” Applicants respectfully traverse the rejection.

Claim 42 has been amended to recite, inter alia, “An apparatus, comprising; *at least a first fluid layer and a second fluid layer.*” Thus, the at least first and second fluid layers are part of the apparatus recited in amended claim 42. Applicants respectfully request withdrawal of the rejection.

Claim 49 has been amended to conform with the device illustrated in Fig. 11 and described in paragraph [0067] of the specification. Applicants respectfully request withdrawal of the rejection.

Claims rejections under 35 U.S.C. § 102

The outstanding Official Action has rejected claims 42-48 under 35 U.S.C. § 102 as allegedly being anticipated by Kibar (U.S. Patent No. 6,936,811). Applicants respectfully traverse the rejection.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In rejecting the claims the Examiner states, “Examiner has

interpreted the claim to require a laser that is capable of performing the claimed functions *but has not interpreted the claim to actually require a first and second fluid layer as structural elements.*" (Office action, page 3, section 6, lines 7-9)(Emphasis added.) Claim 42, however, has been amended to recite, inter alia, "An apparatus, comprising; *at least a first fluid layer and a second fluid layer.*" Thus, the at least first and second fluid layers are part of the apparatus recited in amended claim 42.

Kibar, in contrast, discloses a system and method of separating particles by velocity based on physical properties (Kibar, Abstract) in a single medium (column 4, lines 11-12). Kibar does not teach "An apparatus, comprising; *at least a first fluid layer and a second fluid layer*" as recited an amended claim 42. Thus Kibar does not anticipate amended claim 42 or any of the claims that depend from amended claim 42. Applicants respectfully request withdrawal of the rejection.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance. The Director is authorized to charge any fees necessary and/or credit any overpayments to Deposit Account No. 03-3975, referencing Docket No. 043395-0378103.

Respectfully submitted,

Dated: June 3, 2010

By: /Martin Sulsky/

Martin Sulsky
Registration No.: 45,403
Attorney for Applicant(s)

Customer No. 00909
PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. Box 10500
McLean, VA 22102

Application No. 10/573,421
Amendment dated June 3, 2010
Reply to Final Office Action dated March 4, 2010

Atty. Docket No. 043395-0378103

Telephone: 703-770-7900
Facsimile: 703-770-7901